

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ASHOK K. SHUKLA,

MUKTA M. SHUKLA and AMITA M. SHUKLA

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2005-2478

Application No. 09/591,009

HEARD: November 15, 2005

Before OWENS, KRATZ and FRANKLIN, Administrative Patent Judges.  
KRATZ, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

This is in response to appellants' request for rehearing of our November 30, 2005 decision, which request was filed on January 30, 2006. In that decision, we affirmed the examiner's decision to reject claims 1, 2, 4, 5, 7-11, 13-16 and 20 under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Valaskovic; to reject claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Valaskovic in view of Sanford; and to reject claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Valaskovic in view of Sanford and Golias.

The appropriate rule in effect as of September 13, 2004, is 37 CFR § 41.52(a)(1) which states in relevant part "[a]rguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section." Paragraphs (a)(2) and (a)(3) of this section do not allow for admission of the copy of the letter from Dr. Stevenson that was submitted with the rehearing request at this point in time in the appeal. Thus, appellants' request for rehearing is improper in that regard. Pertinent parts of this rule are reproduced below, with text in bold for emphasis only:

**§ 41.52 Rehearing.**

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. **Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.** When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions

specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

(2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

(b) Extensions of the time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

The same result would have been reached if the request for rehearing had been filed at a time when the previous rules of practice before the Board were in effect. Specifically, the copy of the Dr. Stevenson letter would have been considered under the then existing provisions of 37 CFR § 1.195 which provided "[a]ffidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented." The request for rehearing, filed January 30, 2006, does not include such a showing and thus would have been improper under the provisions of that old rule.

In view of the above, we do not consider appellants' new evidence (Dr. Stevenson letter dated November 14, 2005) raised in the Request.

In the Rehearing Request, appellants take us through a partial recapitulation of the prosecution history of the application on appeal and alleged difficulties appellants encountered in attempting to amend the application claims before the examiner, after the examiner's final rejection.

However, no matter how sympathetic the Board of Patent Appeals & Interferences (Board) may be to prosecution difficulties appellants may have encountered before the examiner, the Board is not the proper forum for resolving procedural disputes as to the non-entry of an amendment by the examiner.

See footnote 3 at page 5 of our decision mailed November 30, 2005. That was fully explained to appellants at the oral hearing.

At best, in the rehearing request, the only relevant issue appellants seem to raise is that we erred in our decision by not considering appellants' invention as it pertains to a pipette tip chromatographic particles that are larger than pipette tip perforations. We disagree. This is so because the appealed

claims were not so limited. As we stated at page 5 of the November 30, 2005 decision (footnote omitted) :

Structural features that are disclosed in appellants' specification but not claimed do not distinguish the claimed invention from the applied prior art. This is so because the claims are the measure of the invention sought to be protected by appellants, not the specification. Consequently, our review of the merits of the examiner's rejections focuses on the scope of the claimed subject matter versus what is disclosed in the applied prior art.

While appellants' specification discloses a pipette tip with perforation(s) having dimensions relative to the size of chromatography particles held in the tip such that those particles can not pass through the tip (see, e.g., the description of Figures 3 and 4 at page 8 of appellants' specification), all of the appealed claims before us, and in particular argued claim 1, do not recite such a limitation.

Appellants' request for rehearing does not particularly state any other points believed to have been misapprehended or overlooked in rendering the prior decision or state any other grounds upon which rehearing is properly sought. In this regard, we do not find that the request for rehearing points to any argument set forth in the briefs before us that we overlooked or misapprehended in reaching our decision of November 30, 2005.

If appellants desire the agency to make a new patentability determination based upon different claims than those before us in this appeal and/or on newly proffered evidence and arguments, the proper procedure is for appellants to place the case back before

the examiner with the new evidentiary record and claims. Filing a timely and proper continuing application under the conditions specified in 35 U.S.C. §§ 120, 121 or 365(c), and 37 CFR 1.78(a) would be a way to place the application subject matter back before the examiner with new claims that applicants desire to prosecute. The option to file a continuing application was explained to appellants at the oral hearing.

Of course as set forth in 35 U.S.C. § 120, any continuing application of this application must be filed "before the patenting or abandonment of or termination of proceedings on" this application.

For the above reasons, appellants' request for rehearing is granted to the extent that we have reconsidered our decision, but is denied with respect to making any change thereto.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED

*Terry J. Owens*  
TERRY J. OWENS )  
Administrative Patent Judge )  
 )  
*Peter F. Kratz*  
PETER F. KRATZ ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
 ) AND  
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*Beverly A. Franklin*  
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